

REMARKS/ARGUMENTS

Applicant appreciates the Examiner's clarification that all of the pending claims (Claims 2-12 and 14-25) are rejected based upon the teachings of Wagner in view of Lee in the telephone message of January 31, 2007. The rejection has been considered but is believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses the §103(a) rejection based upon the teachings of U.S. Patent No. 6,258,516 to Wagner *et al.* (hereinafter "Wagner") in view of U.S. Patent No. 7,111,044 to Lee (hereinafter "Lee") because the asserted references, alone or in combination, do not teach or suggest each of the claimed limitations. For example, Wagner does not teach a processing unit that receives a shorthand for a destination of an electronic message from a user interface, as claimed in each of the independent claims. In contrast, the cited portion of Wagner at column 1, lines 49-50 teaches specifying a destination telephone number "for the purpose of initiating an outgoing call." The relied-upon portion makes no mention of a shorthand or of a destination for an electronic message. Wagner's discussion of a speed dial mode 41 also indicates that it is directed only to initiating telephone calls and that it is entirely separate from the messages mode 42 (Fig. 3B and column 5, lines 55-65). Moreover, the discussion of an auto-reply mode for e-mail messages makes no mention of entering a shorthand for a destination. The send button in this mode is not a shorthand for a destination as it does not correspond with a specified destination but instead depends upon which message is selected. This is further illustrated by the fact that only a reply message may be sent using this mode; a new message cannot be sent to a desired address by merely pressing the send button. Examples of the claimed shorthand are further described in the Specification at paragraphs [0032] and [0033]. As Wagner does not, and Lee has also not been shown to, teach at least these limitations, any combination of these teachings also must fail to teach such limitations. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the rejection of independent Claim 7, the Examiner acknowledges that Wagner does not teach a touch pad user interface element and a processing unit configured to recognize a special touch as a shorthand for a destination. In an attempt to overcome this deficiency, Lee's teaching of a touch screen is relied upon. However, while Lee teaches that touch screens are known at column 3, lines 61-64, Lee does not teach or suggest that a special touch may be recognized as a shorthand for a message destination. None of the cited portions of Lee teach or suggest such limitations. Thus, neither of the asserted references teaches at least these limitations; therefore, any combination of these teaching also must fail to teach such limitations. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection of Claim 7 is improper. Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the rejection of independent Claim 8, the Examiner acknowledges that Wagner does not teach a motion-sensing device as a user interface element and a processing unit configured to recognize a special motion as a shorthand for a destination. In an attempt to overcome this deficiency, the Examiner cites column 5, lines 25-29 of Lee. However, this cited portion is directed to software that manipulates a display, captures speech, and captures input data from various input devices, none of which are taught as being a motion-sensing device. Moreover, Lee does not appear to suggest such limitations as Lee does not use the terms "motion" or "movement." As neither of the asserted references teaches or suggests at least these limitations, any combination of these teaching also must fail to teach such limitations. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection of Claim 8 is improper, and Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the rejection of independent Claim 11, the Examiner asserts that Wagner teaches an electronic message being a digital image or drawing created by means of a camera or a touch pad at column 4, lines 37-40. However, this cited portion merely teaches that the GUI of Wagner can store electronic mail (e-mail). There is no mention of a digital image, drawing, or a camera, and the Examiner has previously acknowledged that Wagner does not teach a touch pad. Since Claim 11 has been amended

to remove limitations directed to a digital representation of sound, the cited portion of Wagner does not teach the asserted limitations, and none of the other message options are asserted as being taught by Wagner, correspondence has not been shown to each of the claimed limitations of Claim 11. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection of Claim 11 is improper, and Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the rejection of independent Claim 14, it has not been shown where either of the asserted references teaches wireless transmitting means for transmitting an electronic message with user-defined contents via a Wireless Local Area Network (WLAN). Further, the reliance upon column 6, lines 41-50 of Wagner is misplaced as this portion does not teach any of the claimed types of user-defined contents. The cited portion merely teaches that an e-mail message can be displayed to a user. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection of Claim 14 is improper, and Applicant accordingly requests that the rejection be withdrawn.

Dependent Claims 2-6, 9, 12, 15-18 and 20-25 depend from independent Claims 11, 14 and 19, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Wagner and Lee. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 11, 14 and 19. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-6, 9, 12, 15-18 and 20-25 are also allowable over the combination of Wagner and Lee.

In addition to having to show that the asserted combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to combine these references as asserted. Applicant respectfully submits that this requirement has not been met.

The requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to combine the references is “for the purposes of being user friendly”, “for the purposes of being more versatile and offering extra services”, and “for the purposes of being widely available communication of data”. No evidence, in the form of citations or otherwise, has been provided that a skilled artisan would have attempted to introduce the asserted group chat features of Lee to the device of Wagner.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). As the requisite objective evidence has not been provided, Applicant respectfully asserts that the Examiner’s conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant’s disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation

is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejection be withdrawn.

Applicant notes that Claims 11, 14 and 19 have been amended to remove limitations directed to a digital representation of sound. As these changes remove limitations, they do not introduce new matter. These claims are believed to be patentable over the asserted references for the reasons discussed above.

It should also be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.078PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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